

### **REMARKS**

In the Office Action<sup>1</sup>, the Examiner rejected claims 6, 8-10, and 12-22 under 35 U.S.C. § 112, first paragraph; rejected claims 6, 8-10, and 12-22 under 35 U.S.C. § 112, second paragraph; rejected claims 6, 8-10, 12-18, and 20-22 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,714,797 to Rautila ("*Rautila*") in view of U.S. Patent No. 6,697,944 to Jones et al. ("*Jones*") in further view of U.S. Patent No. 6,604,681 to Burke et al. ("*Burke*"); and rejected claim 19 under 35 U.S.C. § 103(a) as being unpatentable over *Rautila* in view of *Jones* in further view of *Burke* and "Official Notice."

Applicant thanks Examiner Refai for the telephone interview on March 31, 2009. During the interview, the issues raised in the Office Action were discussed, and the substance of the interview is included in the remarks below.

Applicants amend claims 6, 10, 15, and 16. Claims 6, 8-10, and 12-22 remain pending.

The Examiner rejected claims 6, 8-10, and 12-22 under 35 U.S.C. § 112, first paragraph, apparently alleging that the claim recitation "enabling the customer to view on a screen of the store information terminal physical commodities that are available for purchase, in addition to the electronic content items" lacks support in the specification (Office Action at page 3). This allegation is incorrect.

As set forth in the MPEP, "[t]here is no requirement that the words in the claim must match those used in the specification disclosure. Applicants are given a great

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

deal of latitude in how they choose to define their invention so long as the terms and phrases used define the invention with a reasonable degree of clarity and precision."

See *M.P.E.P.* § 2173.05(e), 8th Ed., Rev. 6 (Sept. 2007).

The specification discloses, "an opening screen displayed as described above at each of the store terminals 5A to 5N. On this opening screen, in the screen center, a mascot character for the goods distribution system 1 is displayed and around this, car, book, shopping, photo print, message service, music download, and ticket menus are displayed" (emphases added) (page 21, lines 8-14). The specification further discloses, for example, "the car menu (on the opening screen) is used to open menu screens of various car-related services" including "retrieval and sale of a new car and a used car" (page 21, lines 15-19). A car is a physical commodity. The specification also discloses, "when the downloading of music is selected by the user, in response to a user's operation, the user is instructed to load the memory card 16, and a music file selected by the user is downloaded into the memory card" (page 21, lines 1-4). A music file is an electronic content item. The specification also discloses, "the music download is used to purchase music provided by the content providers 3A to 3N. This enables the store terminals 5A to 5N to be used for various purposes other than purchase of music" (page 23, lines 11-14).

Therefore the claimed features of, "enabling the customer to view on a screen of the store information terminal physical commodities that are available for purchase, in addition to the electronic content items" is fully supported by the specification. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 6, 8-10, and 12-22 under 35 U.S.C. § 112, first paragraph.

The Examiner rejected claims 6, 8-10, and 12-22 under 35 U.S.C. § 112, second paragraph, because the claims "fail[ ] to particularly point out and distinctly claim the subject matter which applicant regards as the invention" (Office Action at page 4).

The Examiner states,

[c]laims 6 and 10 appear disjointed. The claims were originally directed to a method and system for providing electronic content to a customer using a remote terminal and a store terminal via a first and a second communication channel. Now the claims include the limitation directed to enabling the customer to view commodities on a screen of the store terminal which appears to be part of a different embodiment unrelated to the method originally presented

(Office Action at page 4). This is not correct.

Claims 6 and 10 are directed toward providing electronic content to a customer using a remote user terminal and a store information terminal. These claims recite selecting an electronic content item using the remote user terminal and obtaining an identification code for the selected electronic content item. These claims further recite enabling the customer to download the electronic content item at the store information terminal. Claims 6 and 10 also recite enabling the customer to view physical commodities on a screen of the same store information terminal, in addition to the electronic content items. Therefore, claims 6 and 10 particularly point out and distinctly claim the subject matter of the invention.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 6, 8-10, and 12-22 under 35 U.S.C. § 112, second paragraph.

Applicant respectfully traverses the rejection of claims 6, 8-10, 12-18, and 20-22 under 35 U.S.C. § 103(a) as being unpatentable over *Rautila* in view of *Jones* in further view of *Burke*. A *prima facie* case of obviousness has not been established.

During the telephonic interview, Applicant's representative pointed out that *Rautila* fails to teach or suggest the "identification code corresponds only to the electronic content item" (emphasis added), as recited in independent claims 6 and 10. The Examiner stated that amending claims 6 and 10 to recite "accessing a menu including a plurality of electronic content items, each having an identification code" and "obtaining the identification code, via a first communication channel, for identifying the selected electronic content item" would allow claims 6, 8-10, and 12-22 to overcome the rejections under 35 U.S.C. § 103(a) in the Office Action. Applicant has amended claims 6 and 10 in accordance with the Examiner's suggestion.

Accordingly, *Rautila*, *Jones*, and *Burke* fail to render the subject matter recited in claims 6, 8-10, 12-18, and 20-22 obvious.

Furthermore, the Examiner relies on "Kaplan" to reject claims 17 and 18 (Office Action at page 7). However, the Office Action does not specify what "Kaplan" represents. During the telephonic interview, the Examiner stated that this is probably a typographical error and requested that this deficiency be noted in this response.

Applicant respectfully traverses the rejection of claim 19 under 35 U.S.C. § 103(a) as being unpatentable over *Rautila* in view of *Jones* in further view of *Burke* and "Official Notice." A *prima facie* case of obviousness has not been established.

As set forth above, Applicant has amended the claims in accordance with the Examiner's suggestion to overcome the rejections under 35 U.S.C. § 103(a) in the Office Action. Accordingly, *Rautila* in view of *Jones* in further view of *Burke* and "Official Notice" does not render the subject matter of claim 19 obvious.

Furthermore, the Examiner alleges, “per claim 19, Rautilia fails to teach *wherein a list of scheduled concerts related to an artist is displayed on the screen when a ticket menu is selected by a the customer*. However, ‘Official Notice’ is taken that the concept and advantage of this feature is well known in the art” (emphasis in original) (Office Action at page 8).

Applicant traverses the Examiner’s taking of “Official Notice,” noting the impropriety of this action, as the Federal Circuit has “criticized the USPTO’s reliance on ‘basic knowledge’ or ‘common sense’ to support an obviousness rejection, where there was no evidentiary support in the record for such a finding.” MPEP § 2144.03. Applicant submits that “[d]eficiencies of the cited references cannot be remedied by ... general conclusions about what is ‘basic knowledge’ or ‘common sense.’” In re Lee, 61 USPQ2d 1430, 1432-1433 (Fed. Cir. 2002), quoting In re Zurko, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

Should the Examiner maintain the rejection after considering the reasoning presented herein, Applicant submits that the Examiner must provide “the explicit basis on which the examiner regards the matter as subject to official notice and allow Applicants to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made,” or else withdraw the rejection. See MPEP § 2144.03.

Here, the Examiner appears to rely upon alleged what is “well known in the art.” As stated in M.P.E.P. § 2144.03, such assertions are not proper because the Examiner has not demonstrated that the asserted facts are well-known or capable of instant and

unquestionable demonstration as being well-known in the art. Therefore, the rejection of claim 19 is improper.


In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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